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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/729,583	12/05/2003	Ho Chi Fai	150C3	2227

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EXAMINER

CHENG, JOE H

ART UNIT PAPER NUMBER

3713

DATE MAILED: 06/15/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary	Application No. 10/729,583	Applicant(s) HO ET AL.	
	Examiner Joe H. Cheng	Art Unit 3713	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☐ Responsive to communication(s) filed on 5/11/05, 8/13, 8/3, 5/13, 5/6/04 & 12/5/03.
- 2a) ☐ This action is FINAL. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 82-115 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 82-115 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 05 December 2003 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☒ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|---|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date <u>5/12/05, 2/22/05, 1/7/04</u> | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

Reissue Applications

1. In response to the Preliminary Amendments filed on December 5, 2003, May 6, 2004, May 13, 2004, August 3, 2004, August 12, 2004 and May 11, 2005, claims 1-81 have been cancelled and the newly added claims 82-115 are pending. In addition, applicant is informed that all the publications cited in the IDS filed on May 12, 2005, which are crossed out by the Examiner, have not been considered by the Examiner, because CFR § 1.98 requirement is not met. Specifically, the publication date is missing.

2. The reissue oath/declaration filed with this application is defective (see 37 CFR 1.175 and MPEP § 1414) because of the following:

The reissue oath/declaration filed with this application is defective because the error which is relied upon to support the reissue application is not an error upon which a reissue can be based. See 37 CFR 1.175(a)(1) and MPEP § 1414.

The reissue application was filed without the required offer to surrender the original patent or, if the original is lost or inaccessible, an affidavit or declaration to that effect. The original patent, or a statement as to loss or inaccessibility of the original patent, must be received before this reissue application can be allowed. See 37 CFR 1.178.

3. Claims 82-115 are rejected under 35 U.S.C. 251 as being enlarging the scope of the claims of the original patent in a reissue application filed outside the two years statutory period. It is noted that a claim is broadened if it is broader in any one respect

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even though it may be narrower in other respects. Applicant intended to change the newly added claims 82-115 to correct the errors arose on claim 1 of the original patent are improper. Specifically, all the claims of the original patent are cancelled and not amended; hence, the error does not exist.

4. Applicant is notified that any subsequent amendment to the specification and/or claims must comply with 37 CFR 1.173(b) and 1.173(c).

The amendment filed on December 5, 2003, May 6, 2004, May 13, 2004, August 3, 2004, August 12, 2004 and May 11, 2005 proposes amendments to claims 82-115 that do not comply with 37 CFR 1.173(b) and 1.173(c), which sets forth the manner of making amendments in reissue applications. A supplemental paper correctly amending the reissue application is required.

Claim Rejections - 35 USC § 102

5. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(a) the invention was known or used by others in this country, or patented or described in a printed publication in this or a foreign country, before the invention thereof by the applicant for a patent.

Claim Rejections - 35 USC § 103

6. This application currently names joint inventors. In considering patentability of the claims under 35 U.S.C. 103(a), the examiner presumes that the subject matter of the various claims was commonly owned at the time any inventions covered therein were made absent any evidence to the contrary. Applicant is advised of the obligation under 37 CFR 1.56 to point out the inventor and invention dates of each claim that was not commonly owned at the time a later invention was made in order for the examiner to

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consider the applicability of 35 U.S.C. 103(c) and potential 35 U.S.C. 102(e), (f) or (g) prior art under 35 U.S.C. 103(a).

7. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

The factual inquiries set forth in *Graham v. John Deere Co.*, 383 U.S. 1, 148 USPQ 459 (1966), that are applied for establishing a background for determining obviousness under 35 U.S.C. 103(a) are summarized as follows:

1. Determining the scope and contents of the prior art.
2. Ascertaining the differences between the prior art and the claims at issue.
3. Resolving the level of ordinary skill in the pertinent art.
4. Considering objective evidence present in the application indicating obviousness or nonobviousness.

8. Claims 97 and 110 are rejected under 35 U.S.C. 102(a) as anticipated by or, in the alternative, under 35 U.S.C. 103(a) as obvious over “An Update on WebCT (World-Wide-Web Course Tools) A Tool for the Creation of Sophisticated Web-Based Learning Environments” by Goldberg et al (hereinafter as Goldberg et al). The teaching of Goldberg et al broadly discloses the computer-aided group-learning method for more than one user to work on a subject comprising setting a time for group of users to start a dialogue session to work on materials related to the subject so as to provide an interactive environment to help the user learn, allowing the user to register for the session (i.e. Course Calendar Tool), allowing a user to share materials generated by the user with other users, with the user’s changes in materials available to be seen by the other users in real time during the session (i.e. Chat Tool for real-time communication), retrieving

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materials related to the subject during the dialog session for the group of users (i.e. Student Presentation Area), assessing the understanding of at least one user in an area of the subject and customizing the training of a user on the subject based on assessing that the user's understanding during the session, allowing an instructor to observe a user during the session (i.e. Progress Tracking), allowing a user to create notes while working on the subject for later review, allowing the user to extract a portion of the retrieved materials and add the portion to the user's note (i.e. Indexing and Searching, Page Annotation, Page References, Searchable Image Archive, and Course Backup, Restore and Transport Facility), generating a report that includes information regarding the understanding of the at least one user in an at least the area of the subject, wherein the report also can include information regarding the understanding of a number of users as a group in at least one area of the subject (i.e. Questionnaire Delivery and Report, and Student Account Management and Grade Database). It is noted that the teaching of Goldberg et al does not specifically disclose the steps of allowing the user to mark the beginning and the end of a certain section of the retrieve materials so that the certain section can be brought to the user based on the mark, allowing the user to create notes while working on the subject and allowing the user to link a piece of notes created to an area of the materials retrieved as required. However, Goldberg et al teaches that such features of clip-art of the course, the student make personal annotation for that page of notes, and once selected, a single page of content is presented showing all selected pages combined together, so as to allow students to generate their own customized study guides and simplifies printing of multiple pages of content are considered an arbitrary obvious

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design choice or equivalent functions as claimed, so as to provide the student a personal study guide.

9. Claims 82-85, 87-91, 98, 100-104, 106-109, 111, 113 and 114 are rejected under 35 U.S.C. 103(a) as being unpatentable over “An Update on WebCT (World-Wide-Web Course Tools) A Tool for the Creation of Sophisticated Web-Based Learning Environments” by Goldberg et al (hereinafter as Goldberg et al) in view of “Enhancing teaching using the Internet Report of the Working Group on the World Wide Web as an Internet Teaching Resource” by Hartley et al (hereinafter as Hartley et al). It is noted that the teaching of Goldberg et al does not explicitly disclose the steps of allowing some of the user to interact among themselves privately, separate from at least one other user, and among the some of the user, allowing one user to transmit materials to the other users, with the materials available to be received by the other users during the session (as per claim 82), allowing materials related to the subject to be provided to just one user to allow the user to learn during the session (as per claim 89), or retrieving materials related to the subject for a user but not for at least one other user having at least a portion of the dialogue session the system for delivering online during the session (as per claim 98), or among the some of the user, allows one user to transmit materials to the other users, with the materials available to be received by the other users, among the some of the users, allows one user to transmit materials to another user, with the materials available to be received by the another user, in private, and materials on a problem regarding the subject can be sent to the users to allow them to work on the problem (as per claim 100), or asking at least one user a question during the dialogue session, with the question not

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provided to at least one other user (as per claim 101) wherein the materials retrieved related to the subject for at least one of the users is not provided to at least one other user (as per claim 102), or retrieving materials related to the subject for a user and not for at least one other user during the session to allow the user to individually work on the retrieved materials not during the dialogue session (as per claim 108) as required.

However, Hartley et al broadly discloses that such features of allowing some of the user to interact among themselves privately, separate from at least one other user, and among the some of the user, allowing one user to transmit materials to the other users, with the materials available to be received by the other users during the session, or retrieving materials related to the subject for a user but not for at least one other user having at least a portion of the dialogue session the system for delivering online during the session, to allow the user to individually work on the retrieved materials not during the dialogue session, or among the some of the users, allows one user to transmit materials to another user, with the materials available to be received by the another user, in private, and materials on a problem regarding the subject can be sent to the users to allow them to work on the problem, or asking at least one user a question during the dialogue session, with the question not provided to at least one other user wherein the materials retrieved related to the subject for at least one of the users is not provided to at least one other user (see paragraph 2.2.3 to 2.2.5). Hence, it would have been obvious to one of ordinary skill in the art to modify the method of Goldberg et al with the features of allowing some of the user to interact among themselves privately, separate from at least one other user, and among the some of the user, allowing one user to transmit materials to the other users, with the materials available to be received by the other users during the session, or

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retrieving materials related to the subject for a user but not for at least one other user having at least a portion of the dialogue session the system for delivering online during the session, to allow the user to individually work on the retrieved materials not during the dialogue session, or among the some of the users, allows one user to transmit materials to another user, with the materials available to be received by the another user, in private, and materials on a problem regarding the subject can be sent to the users to allow them to work on the problem, or asking at least one user a question during the dialogue session, with the question not provided to at least one other user wherein the materials retrieved related to the subject for at least one of the users is not provided to at least one other user as taught by Hartley et al as both Goldberg et al and Hartley et al are directed to the method and system for creating online course of educational material, so as to provide the customized education courses.

10. Claims 86, 92-96, 99, 105, 112 and 115 are rejected under 35 U.S.C. 103(a) as being unpatentable over “An Update on WebCT (World-Wide-Web Course Tools) A Tool for the Creation of Sophisticated Web-Based Learning Environments” by Goldberg et al (hereinafter as Goldberg et al) in view of “Enhancing teaching using the Internet Report of the Working Group on the World Wide Web as an Internet Teaching Resource” by Hartley et al (hereinafter as Hartley et al) and further in view of Howell (U.S. Pat. No. 5,767,897). It is noted that the teachings Goldberg et al and Hartley et al fails to disclose the steps of allowing the face of at least one user to be seen on the screen by other user during the session (as per claims 86 and 92), wherein the face of another user can be seen on the screen by other users during the session (as per claim 92), or during such dialogue,

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one user can share a drawing with the other users and changes made in the drawing can be seen by the other users as the changes are made (as per claim 99) wherein among some of the users, one user can transmit a drawing to the other users with the drawing available to be received by the other users during the separate dialogue (as per claim 112) as required. However, Figs. 1-5E of Howell broadly discloses that such features of allowing the face of at least one user to be seen on the screen by other user during the session (53), wherein the face of another user can be seen on the screen by other users during the session (62), or during such dialogue, one user can share a drawing with the other users and changes made in the drawing can be seen by the other users as the changes are made (see Fig. 4). Hence, it would have been obvious to one of ordinary skill in the art to modify the method of Goldberg et al and Hartley et al with the features of allowing the face of at least one user to be seen on the screen by other user during the session, wherein the face of another user can be seen on the screen by other users during the session, or during such dialogue, one user can share a drawing with the other users and changes made in the drawing can be seen by the other users as the changes are made as taught by Howell as both Goldberg et al, Hartley et al and Howell are directed to the method and system for creating online course of educational material, so as to provide the interactive dialogue session for one or more users to work on the subject during group learning.

Conclusion

7. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure.

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Matsuba et al (U.S. Pat. No. 5,255,347) - note Figs. 1-26;

Kubo (U.S. Pat. No. 5,306,878) - note Figs. 1-13;

Ludwig et al (U.S. Pat. No. 5,758,079) - note Figs. 1-42;

Ahamed et al (U.S. Pat. No. 5,809,493) - note Figs. 1-5;

Boyer (U.S. Pat. No. 5,896,128) - note Figs. 1-18;

Parry et al (U.S. Pat. No. 6,077,085) - note Figs. 1-15;

Remschel (U.S. Pat. No. 6,141,529) - note Figs. 1-23;

Taylor et al (U.S. Pat. No. 6,292,830 B1) - note Figs. SS1-1 – SS4-1;

Kondo (U.S. Pat. No. 6,396,954 B1) - note Figs. 1-9;

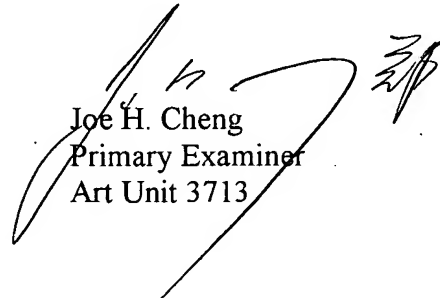
Dornbush et al (U.S. Pat. No. 6,471,521 B1) - note Figs. 1-8A.

8. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Joe H. Cheng whose telephone number is (703)308-2667. The examiner can normally be reached on Tue.- Fri..

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Xuan Thai can be reached on (703)308-2064. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

Joe H. Cheng
June 10, 2005


Joe H. Cheng
Primary Examiner
Art Unit 3713